

REMARKS

Claims 2-18, 20 and 22-29 are pending in this application. By this Amendment, Claims 1, 19 and 21 are canceled without prejudice or disclaimer. Claim 23 and the specification have been amended merely to correct typographical errors, Claims 3, 5-9, 14, 18 and 20 are amended merely to depend from an allowable claim and Claims 28 and 29 have been added, which also merely add allowable features of allowed Claim 2 as dependent claims from Claims 24 and 27. Entry of the Amendment is proper, as no new matter has been presented and no new issues have been raised. Reconsideration in view of the following remarks is respectfully requested.

Applicants gratefully acknowledge the Office Action's indication that Claims 2, 4, 12, 13, 15-17, 22, 23, 25 and 26 define patentable subject matter. However, for at least the reasons set forth below, Applicants respectfully submit that all pending claims are in condition for allowance.

I. 35 U.S.C. §102(b)

The Office Action rejects Claims 1, 3, 5, 6, 14, 18, 21, 24 and 27 under 35 U.S.C. §102(b) over McCarty et al. (U.S. Patent No. 3,744,496, hereinafter "McCarty"). The rejection is moot with regards to Claims 1 and 21 in view of the cancellation of these claims and with regard to Claims 3, 5, 6, 14 and 18 which now depend from allowable Claim 2. The rejection is respectfully traversed with regard to Claims 24 and 27.

Claim 24 recites a cigarette of an electrical smoking system comprising a tobacco web surrounding a tobacco rod, a paper wrapper surrounding the tobacco

web, and an optional filter at one end of the cigarette, the paper wrapper comprising a cellulosic web material and at least one filler therein, the filler being effective to reduce the content of gaseous components in mainstream smoke produced by combustion/pyrolysis of the cigarette in the electrical smoking system.

Claim 27 recites a cigarette of an electrical smoking system comprising a tobacco web surrounding a tobacco rod, a paper wrapper surrounding the tobacco web, and an optional filter at one end of the cigarette, the tobacco web comprising tobacco and at least one filler therein, the filler being effective to reduce the content of gaseous components in mainstream smoke produced by combustion/pyrolysis of the cigarette in the electrical smoking system.

The Office Action dated January 22, 2004 states that McCarty discloses all that is recited in the claims. See page 3, item 3. Further, the Office Action states on page 6, item 9, that McCarty discloses that tobacco materials can serve as the fiber pulp for the wrapper. However, McCarty merely discloses that a furnish of fiber pulp and carbon filler is used to make a paper sheet and that pulped tobacco stalks or stems, to which is added the carbon filler or the carbon, may be added to the furnish used in making reconstituted tobacco sheets for cigar wrap. See column 2, lines 23-35. McCarty clearly fails to disclose or suggest, the combination of features recited in Claim 24, i.e., a cigarette of an electrical smoking system comprising a tobacco web surrounding a tobacco rod, a paper wrapper surrounding the tobacco web, and an optional filter at one end of the cigarette, the paper wrapper comprising a cellulosic web material and at least one filler therein, the filler being effective to reduce the content of gaseous components in mainstream smoke produced by combustion/pyrolysis of the cigarette in the electrical smoking system.

Rather, with respect to Claim 24, McCarty merely discloses a paper sheet which can be made from a furnish of fiber pulp which may be pulped tobacco stalks or stems, but does not include both a tobacco web surrounding a tobacco rod and a paper wrapper surrounding the tobacco web, where the paper wrapper comprises a cellulosic web material and at least one filler therein, the filler being effective to reduce the content of gaseous components in mainstream smoke produced by combustion/purolysis of the cigarette in an electrical smoking system, as recited in Claim 24.

Furthermore, McCarty further fails to disclose or suggest, the combination of features as recited in Claim 27, i.e., a cigarette of an electrical smoking system comprising a tobacco web surrounding a tobacco rod, a paper wrapper surrounding the tobacco web, and an optional filter at one end of the cigarette, the tobacco web comprising tobacco and at least one filler therein, the filler being effective to reduce the content of gaseous components in mainstream smoke produced by combustion/pyrolysis of the cigarette in the electrical smoking system. Similarly, with respect to Claim 27, McCarty also fails to disclose or suggest at least the feature of both a tobacco web surrounding a tobacco rod, a paper wrapper surrounding the tobacco web, where the tobacco web comprises tobacco and at least one filler therein.

For at least the reasons set forth above, Applicants respectfully submit that Claims 24 and 27 are allowable. As Claims 3, 5, 6, 14 and 18 now depend from Claim 2, Applicants further submit that these claims are also allowable. Withdrawal of the rejection is respectfully requested.

II. 35 U.S.C. §103(a)

A. Claims 7-11 and 19 Arguments on Claims 7-11 and 19

The Office Action rejects Claims 7-11 and 19 under 35 U.S.C. §103(a) over McCarty. Claim 19 has been canceled without prejudice or disclaimer, therefore the rejection of Claim 19 is moot. Claims 7-9 have been amended to depend from allowable Claim 2, and Claims 10 and 11 depend from Claims 9-10, respectively, therefore the rejections of Claims 7-11 is moot. The rejection is respectfully traversed.

Claims 7-11 depend from Claim 2, which has been indicated to be allowable, and are allowable for at least the same reasons, as well as their added features and the combinations thereof. Withdrawal of the rejection is respectfully requested.

B. Arguments on Claim 20

The Office Action rejects Claim 20 under 35 U.S.C. §103(a) over McCarty in view of Baldwin et al. (U.S. Patent No. 5,263,500, hereinafter "Baldwin"). Since Claim 20 has been amended to depend from allowable Claim 2, Applicants respectfully submit that the rejection of Claim 20 is moot. The rejection is respectfully traversed.

Applicants submit that the above amendments to Claim 20 render Claim 20 allowable. Withdrawal of the rejection is respectfully requested.

III. Double Patenting Rejection

The Office Action rejects Claims 1-27 under the judicially created doctrine of obviousness-type double patenting over claims 1-27 of U.S. Patent No. 6,289,898.

As noted in the Office Action, Applicants submit herewith a Terminal Disclaimer.

Withdrawal of the rejection is respectfully requested.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: April 22, 2004

By: 

Laura L. Lee

Registration No. 48,752

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

VA 63575.1